

6

Docket No. GJE-75
Serial No. 09/856,944Remarks

Claims 11-26 and 31-34 were pending in the subject application. By this Amendment, claims 11 and 31 have been amended. Accordingly, claims 11-26, and 31-34 are currently before the Examiner. Support for the amendments can be found throughout the subject specification including, but not limited to, page 3, lines 9-13; page 5, lines 6-11; and Figures 1 and 7. Favorable consideration and entry of the amendments presented herein are respectfully requested.

The amendments to the claims have been done to lend greater clarity to the claimed subject matter and to expedite prosecution. The amendments to the claims should not be taken to indicate the applicant's agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited. The undersigned avers that no new matter is introduced by this amendment.

As an initial matter, the applicant wishes to thank Examiner Mathew for the courtesy extended to the undersigned during the personal Examiner Interview conducted on April 20, 2004. This response and the amendments set forth herein are submitted in accordance with the substance of the interview. Specifically, in order to expedite prosecution, claims 11 and 31 have been amended to clarify that a portion of at least one absorbent material is located below the fastening means within the enclosure and to emphasize the unique and advantageous ability of this device and method to promote wound healing.

Claims 11-13, 15-18, 21-23, 25-26, and 31-33 have been rejected under 35 U.S.C. §102(b) as being anticipated by Liman (U.S. Patent No. 3,741,203). The applicant respectfully traverses this grounds for rejection because the Liman reference does not disclose the specific aspects of the device and method of the claimed invention that make this invention particularly useful for treating a wound on a limb.

The subject device and method of use have several aspects that are readily distinguishable from the Liman covering. In particular, the current invention advantageously promotes healing of wounds on a limb by providing a warm and moist environment about the wound. Although a warm and moist environment is beneficial for wound-healing, the continual presence of water often causes excoriation of uninjured areas on the limb. To address this problem, the current applicant's device

J:\SH-RESP\GJE\GJE2\GJE-75-2amend.doc\DNB\la

has at least one fluid-absorbent material, where a portion of the fluid-absorbent material is positioned below a fastening means and is in contact with an unaffected part of the limb to prevent excoriation.

In contrast, the Liman reference describes a protective covering for use in preventing water or other contaminants from entering an enclosure and contacting the limb within the covering. To ensure that no water or contaminant enters the covering, an annular foam is secured adjacent underneath (not below) the open mouth of the Liman covering (see, for example, col. 4, lines 44-61; Figure 2). A means adjacent the open mouth of the Liman covering is provided to compress the annular foam against the skin to preclude entry of water or other contaminants. Liman neither discloses nor suggests a device and method of use for treating a wound on a limb. Moreover, the Liman covering lacks an absorbent layer that is positioned such that a portion of the absorbent layer is below the fastening means. In contrast to the Liman device, which merely provides a protective cover against water or contaminants, the present invention provides devices and methods for the treatment of a wound while preventing excoriation of unaffected skin.

It is basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

In *Dewey v. Almy Chem. Co. v. Mimex Co.*, Judge Learned Hand wrote:

No doctrine of the patent law is better established than that a prior patent . . . to be an anticipation must bear within its four corners adequate directions for the practice [of the subsequent invention] . . . if the earlier disclosure offers no more than a starting point . . . if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation. 124 F.2d 986, 990; 52 USPQ 138 (2nd Cir. 1942).

As noted above, the Liman reference does not disclose devices or methods for treating a wound on a limb. Moreover, Liman fails to describe securing a device over a limb such that a portion of a fluid-absorbent layer is positioned below the fastening means. By doing so, the present invention provides a particularly advantageous device and method in which a warm and moist environment is presented to treat a wound, while simultaneously preventing possible excoriation of unaffected portions of the limb. Thus, under the applicable statutory and case law, the Liman reference does not anticipate the current applicant's claims. Therefore, reconsideration and withdrawal of the rejection under 35 USC §102(b) is respectfully requested.

Claims 14, 19-20, and 35 have been rejected under 35 U.S.C. §103(a) as obvious over Liman in view of Shuler (U.S. Patent No. 2,690,415). The applicant respectfully traverses this grounds of rejection because the Liman reference in view of the Schuler reference do not teach or suggest the claimed device.

In addressing this rejection, the applicant hereby incorporates and resubmits his remarks concerning the Liman reference as set for in the preceding paragraphs. As described above, the Liman reference neither discloses nor suggests a device, wherein the device includes at least one fluid-absorbent material, a portion of which is located below the fastening means. The Shuler reference teaches an odor-absorbent material for use in medical dressings. The Shuler reference does not teach, either expressly or impliedly, a device that provides a warm and moist environment to promote the healing of a wound. Further, the Shuler reference fails to disclose a fluid-absorbent material within the device, wherein a portion of the fluid-absorbent material is positioned over unaffected portions of the limb and below the fastening means. There is no reason to think that one skilled in the art, having both the Liman and Shuler references, would be motivated to modify the Liman device to position a portion of a fluid-absorbent material over unaffected portions of the limb and below the fastening means to prevent excoriation.

A finding of obviousness is proper only when the prior art contains a suggestion or teaching of the claimed invention. Here, it is only the applicant's disclosure that provides such a teaching, and the applicants' disclosure cannot be used to reconstruct the prior art for a rejection under §103.

This was specifically recognized by the CCPA in *In re Spinnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969):

The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is we must review the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 112 USPQ 364 (1959); *In re Sprock*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20 (1968). (Emphasis in original)

The mere fact that the purported prior art could have been modified or applied in a manner to yield applicant's invention would not have made the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a §103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art. . . ." *In re Dow Chemical Co.*, *supra* at 1531. (emphasis added)

The applicant respectfully submits that the cited references do not provide any suggestion to make a device that provides a warm and moist environment for a wound on a limb while preventing excoriation of unaffected portions of the limb. A person skilled in the art at the time of the subject invention, even having knowledge of the Liman and Shuler references would have had no motivation to, advantageously and unexpectedly, create a moist and warm environment to promote wound healing, and to provide a fluid-absorbent material within the enclosure and below the fastening means to prevent excoriation of unaffected portions of the limb. Accordingly, reconsideration and withdrawal of this rejection under 35 USC §103(a) is respectfully requested.

Claim 24 has been rejected under 35 U.S.C. §103(a) as obvious over Liman in view of Augustine (U.S. Patent No. 5,947,914). The applicant respectfully traverses this grounds of rejection because the neither the Liman reference nor the Augustine reference disclose or suggest a device that promotes a warm and moist environment for a wound while ensuring the unaffected portion of a limb remains dry to prevent excoriation.

10

Docket No. GJE-75
Serial No. 09/856,944

In addressing this rejection, the applicant hereby incorporates and resubmits his remarks concerning the Liman reference as set forth in the preceding paragraphs. The Augustine reference discloses a wound covering with a reservoir to release medicaments. An important aspect of the subject invention is the fluid-absorbent material, a portion of which is located below the fastening means. This presence as well as location of the fluid-absorbent material is particularly advantageous in that it prevents excoriation of unaffected areas on the limb. This is not disclosed or suggested by the Augustine reference. Consequently, the skilled artisan would have had no reason to look to the Augustine reference for guidance in developing a device that not only treats wounds but prevents excoriation of unaffected portions on the limb. Thus, the Augustine reference fails to remedy, or even address, the defects noted in the Liman reference. Accordingly, reconsideration and withdrawal of this rejection under 35 U.S.C. §103(a) is respectfully requested.

In view of the foregoing remarks and the amendment above, the applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

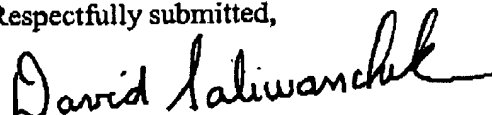
J:\SH-RESP\QJE\GJE\GJE-75-2amend.doc\DNB/la

11

Docket No. GJE-75
Serial No. 09/856,944

The applicant also invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



David R. Saliwanchik

Patent Attorney

Registration No. 31,794

Phone: 352-375-8100

Fax No.: 352-372-5800

Address: 2421 N.W. 41st Street, Suite A-1
Gainesville, FL 32606-6669

DRS/la